

Appl. No. 09/548,728
Amendment and/or Response
Reply to Office action of 6 October 2004

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REMARKS / DISCUSSION OF ISSUES

Claims 1-14 are pending in the application.

The Office action rejects claims 1, 2, 4-7, and 9-14 under 35 U.S.C. 102(b) over Ananda (USP 5,638,513). The applicant respectfully traverses this rejection.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Ananda teaches a security system that assures that a user is connected to a web-site of a provider of software whenever the user is using the software.

Claim 1, upon which claims 2-5 depend, claims a method for limiting simultaneous copies of content material, comprising communicating a copy of the content material to a receiving device, communicating a security challenge to the receiving device when the copy of the content material is communicated to the receiving device, and receiving a security response, based on the security challenge, from the receiving device when the copy of the content material is removed from the receiving device.

Ananda does not teach a method for limiting simultaneous copies of content material. Ananda is silent with regard to the number of copies of the software that the user can use while connected to the web-site.

Ananda does not teach receiving a security response when a copy of the software is removed from the receiving device. Ananda is silent with regard to removing the software from the receiving device.

The Office action cites Ananda, column 9, line 66 through column 10, line 10 for this teaching. The cited text follows:

"One function of the header software 320 is to prevent unauthorized use of the application software 310. The rental security manager 321 performs this function. The rental security manager 321 interfaces with the application software 310 through the interface parameters 315. The rental security manager 321 determines whether the user may continue to access the application software 310 using a series of tests. When the user passes the periodic test, the user is authorized to continue executing the application software 310. When the test fails, the rental security manager 321

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terminates execution of the application software 310 and notifies the user of unauthorized rise." (Ananda, column 9, line 66 through column 10, line 10.)

The applicant respectfully notes that the cited text is silent with regard to removing software from the user's system, and thus cannot be said to teach receiving a security response, based on the security challenge, from the receiving device when the copy of the content material is removed from the receiving device, as specifically claimed in claim 1.

Claim 6, upon which claims 7-10 depend, claims a check-out/check-in device comprising a catalog controller that is configured to provide a limited number of simultaneous copies of content material to one or more receiving devices, an encrypter that is configured to provide a security challenge to a receiving device of the one or more receiving devices when the catalog controller provides a copy of the content material to the receiving device, and a return verifier that is configured to receive a security response from the receiving device when the copy of the content material is removed from the receiving device, and notify the catalog controller whether the security response corresponds to an appropriate response to the security challenge.

As noted above, Ananda does not address removing content material from a receiving device, and thus cannot be said to teach a return verifier that is configured to receive a security response from the receiving device when the copy of the content material is removed from the receiving device, as specifically claimed in claim 6.

Claim 11, upon which claims 12-14 depend, claims a receiving device that receives content material and a corresponding security challenge from a check-out/check-in device, comprising a memory that is configured to store the content material and the corresponding security challenge, and a security device that is configured to erase the content material from the memory, and communicate a security response to the check-out/check-in device, based on the security challenge that is associated with the content material.

As noted above, Ananda does not address removing content material from a receiving device, and thus cannot be said to teach a security device that is configured to erase the content material from a memory, as specifically claimed in claim 11.

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Because Ananda does not teach each element of each of the applicant's independent claims 1, 6, and 11, the applicant respectfully requests the Examiner's reconsideration of the rejection of claims 1, 2, 4-7, and 9-14 under 35 U.S.C. 102(b) over Ananda.

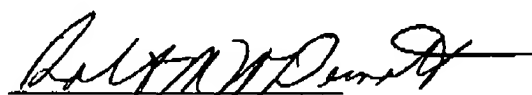
The Office action rejects claims 3 and 8 under 35 U.S.C. 103(a) over Ananda and Bereiter (USP 5,754,763). The applicant respectfully traverses this rejection, based on the above remarks regarding Ananda and claims 1 and 6, upon which these rejected claims depend.

The Office action apparently relies upon Ananda for teaching the elements of independent claims 1 and 6, and Bereiter for teaching a counter that records the number of simultaneous copies of content material.

As noted above, Ananda does not teach each of the elements of independent claims 1 and 6, upon which claims 3 and 8 depend, and the applicant respectfully requests the Examiner's reconsideration of the rejection of claims 3 and 8 under 35 U.S.C. 103(a) over Ananda and Bereiter.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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